



Serial No. 10/091,379
Attorney Docket No. 40021-0008

1712

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application:
Brian A. Jones et al.

Serial No.: 10/091,379 ✓

Filed: March 4, 2002 ✓

For: CHROMATOGRAPHIC PACKING
MATERIALS AND METHODS OF MAKING
AND USING SUCH PACKING MATERIALS

Confirmation No. 9971

Group Art Unit: 1712 ✓

Examiner: Robertson, Jeffrey ✓

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Commissioner for Patents
Washington, D.C. 20231

Mail Stop Non-Final Response

Sir:

REPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action dated March 31, 2003, Applicant requests reconsideration of this application in light of the following remarks.

Claims 1-38 are pending in this application and are subject to a restriction requirement and an election of species requirement.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on this 30th day of April 2003.

Signed: Smiley Foley

Dated: 4/30/03

4/30/2003

The Restriction Requirement

The Office has required restriction to one of the following groups of inventions under 35 U.S.C. § 121:

Group I: claims 1-11, 14-28, and 36-38, drawn to metal oxides treated with polysilanes, classified in class 428, subclass 391;

Group II: claims 12, 13, and 29, drawn to polydentate silanes, classified in class 528, subclass 35; and

Group III: claims 30-35, drawn to metal oxides coated with monomers with particular leaving groups, classified in class 428, subclass 407.

The Office argues that Groups I and II are related as mutually exclusive species in an intermediate-final product relationship and that distinctness exists because the intermediate product is useful to make other than a final product, i.e., Group II is deemed to be useful as an adhesive component. The Office argues that Groups I and III are related as subcombinations disclosed as usable together in a single combination that are distinct from each other because they are separately usable, i.e., Group I has a separate utility such as a filler for silicon rubber compositions. The Office argues that Groups II and III are related as mutually exclusive species in an intermediate-final product relationship and that distinctness exists because the intermediate product is useful to make other than a final product, i.e., Group II is deemed to be useful as an adhesive component.

The Office concludes that because the groups of inventions are distinct for these reasons, and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes is proper.

Applicant elects with traverse to prosecute the invention of Group I, claims 1-11, 14-28, and 36-38. Applicant does NOT traverse the Office's classification of the groups of inventions as distinct and entailing different patentability determinations, merely the reasoning behind the Office's classification.

As to restriction between Groups I and II, Applicant respectfully disagrees that the Office has shown that the invention of Group II is useful as an adhesive component. Attached as Exhibit A are two search results from the Office's patent search database. The searches were for the terms "bidentate (or polydentate) silane" and "adhesive" within the specification of any U.S. patent issued since 1976. Both searches returned no result. Thus, the Office has not established distinctness between the inventions of Groups I and II.

As to restriction between Groups I and III, Applicant respectfully disagrees. The Office categorizes the inventions of Groups I and III as "disclosed as usable together in a single combination." The Office, however, has not established what that "single combination" is or where Applicant has disclosed that the inventions of Groups I and III can be used together in that single combination. Thus, the Office has not established a distinctness between the inventions of Groups I and III.

As to restriction between Groups II and III, Applicant respectfully disagrees that the Office has shown that the invention of Group II is useful as an adhesive component. Attached as Exhibit A are two search results from the Office's patent search database. The searches were for

the terms “bidentate (or polydentate) silane” and “adhesive” within the specification of any U.S. patent issued since 1976. Both searches returned no result. Thus, the Office has not established a distinctness between the inventions of Groups II and III.

Thus, the Office has not established a proper restriction requirement between Groups I, II, and III. Accordingly, Applicant requests withdrawal of this restriction requirement and examination of all pending claims

The Election of Species Requirement

The Office has required election of the patentably distinct species of the claimed invention:

Group A: a method where the monomer is bonded to the substrate and then polymerized, claims 21, 24, and 27; and

Group B: a method where the monomer is polymerized and then bonded to the substrate, claims 22, 25, and 28.

The Office has indicated that claims 16, 23, and 26 are generic to these species.

Applicant elects, with traverse, to prosecute the specie of Group B. Applicant does not provide a list of the claims readable on this specie because the Office has already provided such a list (claims 22, 25, and 28).

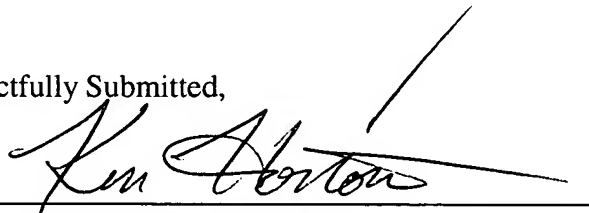
CONCLUSION

For the above reasons, Applicant respectfully requests the Office to withdraw the restriction and election of species requirements and examiner all the pending claims.

If there is any fee due in connection with the filing of this Response, including a fee for any extension of time not accounted for above, please charge the fee to our Deposit Account No. 18-0013.

Respectfully Submitted,

By

A handwritten signature in cursive script, appearing to read "Ken Horton", is written over a horizontal line.

KENNETH E. HORTON

Reg. No. 39,481

Dated: April 30, 2003